

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

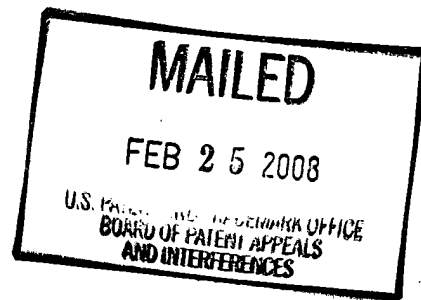
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Ex parte MARK G. O'DONNELL  
AND MILES C. O'DONNELL

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Application No. 10/800,796

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on February 7, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On appellant filed an Appeal Brief. On page 6, under the heading "Grounds of Rejection to be Reviewed on Appeal" the Appellants stated:

The grounds for rejection presented for review in this appeal are as follows. The examiner has rejected each of independent claims 37, 50 and 52 under 35 U.S.C. §103(a) over the Knight reference (U.S. Patent No. 1,435,311).

In response, an Examiner's Answer was mailed on December 20, 2006. While the Answer notes that "The appellant[']s statement of the grounds of rejection to be reviewed on appeal is correct . . ." [page 2], the Examiner's Answer, the following § 103 rejections were made:

Claims 37, 38, 40-43, 46 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 1,435,311 to Knight.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of U.S. 4,929,478 to Conaghan et al.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of U.S. 4,181,157 to DeCamp.

Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight in view of Whittington.

A clarification of the claims to be applied in the rejection is required.

On December 20, 2006, an Examiner's Answer was entered into the record. In the Evidence Relied Upon section, page 3, heading (8), the examiner relied on the following reference:

Declaration as listed in the Appeal Brief

A review of the file reveals that references Knight (US Patent No. 1,435,311) was used in the application of claims 37, 38, 40-43, 46 and 50-53; DeCamp (US Patent No. 4,181,157 used in the application of claim 39; Whittington (US Patent No. 3,762,982) was used in application of claims 47-49; and Conaghan et al. (US Patent No. 4,929,478) was used in application of claims 44 and 45 as stated in the Grounds of Rejection, paragraph (9) of the examiner's answer. The Manual of Patent Examining Procedure, in § 1207.02 states:

(8) ***Evidence Relied Upon.*** A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Before further review, the examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of all references mentioned in the statement of rejections. See the Manual of Patent Examining Procedure, (MPEP) § 1207.02. Appropriate correction is required.

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Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) to give a proper explanation of the grounds of rejection on Appeal;
- 2) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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